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A34060-A-A - 090495.0285  
PATENT

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicants : De Brabander et al.  
Serial No. : 10/790,266 Examiner: Owens, Amelia A.  
Filed : September 5, 2003 Group Art Unit: 1625  
For : SYNTHETIC SALICYLIHALAMIDES, APICULARENS  
AND DERIVATIVES THEREOF

**RESPONSE**

I hereby certify that this paper is being deposited with the United States Postal Service as first class mail in an envelope addressed to: Commissioner for Patents, P.O. Box 1450, Alexandria VA , 20231-2450

November 18, 2004

Date of Deposit

Rochelle K. Seide, Ph.D.

Attorney Name

Signature

32,300

PTO Registration No.

November 18, 2004

Date of Signature

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Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA. 20231-1450

Sir:

This paper is filed in response to the Office Action dated August 25, 2004.

Claims 1-17 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-30 of U.S. Patent No. 6,617,348 to De Brabander

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et al. The Examiner indicates that the conflicting claims are not identical, but are not patentably distinct from each other because they are directed to the same generic concept. The Examiner alleges that claim 1 of the patent and the application are identical with the exception of definition for variable "F." The Examiner also alleges that claims 3 and 12 of the application are identical to claims 2 and 3 of the patent. The Examiner further alleges that one of ordinary skill in the art would be motivated to prepare compounds from the DeBrabander genus to obtain additional pharmaceutical agents, with the expectation that the agents would have similar properties.

A terminal disclaimer is submitted herewith. The terminal disclaimer is accompanied by a copy of the assignment from the inventors to Board of Regents, The University of Texas System and the Recordation Form Cover Sheet submitted concurrently. Applicants note that the filing of this disclaimer is not an admission of the propriety of the rejection of these claims. *See Quad Environmental Technologies Corp. v. Union Sanitary District*, 946 F.2d 870 (Fed. Cir. 1991).

With regard to the Examiner's comments, applicants submit that the currently pending claims and the claims of De Brabander are clearly not identical. The currently pending claims are directed to compounds, whereas the issued patent claims are directed to compositions comprising compounds.

In light of the submission of the disclaimer and the comments presented herein, applicants respectfully request that the rejection of claims 1-17 under the judicially-created doctrine of obviousness-type double patenting be withdrawn and that the pending claims be

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allowed to issue.

Should any additional fees be required or any overpayment made, the Commissioner is hereby authorized to charge any fees or credit any overpayment to Deposit Account 02-4377. A duplicate copy of this page is provided.

Respectfully submitted,

By: 

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